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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049926
Party	Defendant Cloudstreet, Inc. dba Roxbury Entertainment
Correspondence Address	Cloudstreet, Inc. dba Roxbury Entertainment 201 Wilshire Boulevard, Second Floor Santa Monica, CA 90401 UNITED STATES
Submission	Motion to Suspend for Civil Action
Filer's Name	PAUL D. SUPNIK
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Date	10/07/2008
Attachments	Registrant's Motion to Suspend.pdf ( 69 pages )(3941810 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<p>PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC.,</p> <p>Petitioner,</p> <p>v.</p> <p>CLOUDSTREET, INC. DBA ROXBURY ENTERTAINMENT,</p> <p>Registrant.</p>	<p>Cancellation No. 92049926</p> <p>Registration Nos. 3189543; 3194255; 3291736</p> <p>Registered: December 26, 2006; January 2, 2007; September 11, 2007</p> <p>Mark: ROUTE 66</p>
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REGISTRANT'S MOTION TO SUSPEND

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Petitioner CLOUDSTREET, INC. hereby moves to suspend proceedings in the above-captioned cancellation, pursuant to 37 C.F.R. § 2.117. Federal Court litigation is currently pending between these same parties involving the same marks, a trademark infringement, dilution and unfair competition action in the Central District of California filed June 12, 2008, Case No. CV 08-03872 FMC (JWJx) as shown in the Complaint [EXHIBIT 1], and Petitioner's Answer to the

Complaint [EXHIBIT 2] in that Action. In this Federal Court case, a significant issue before the District Court is whether the Registrant's ROUTE 66 Marks are infringed and are confusingly similar to Petitioner's use of ROUTE 66 as a trademark, as raised in this Cancellation Proceeding. The application rule states:

“37 CFR § 2.117 Suspension of proceedings.

(a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.”

The District Court lawsuit, if not in fact dispositive of the issues raised in this Cancellation Proceeding, will have a significant bearing on this Cancellation Proceeding, warranting suspension under 2.117(a).

#### CONCLUSION

Since a civil action is pending, this Cancellation Proceeding should be suspended pending a final decision in the civil action, and Petitioner requests that this matter be suspended under Section 2.117(a).

Dated: October 7, 2008

Respectfully submitted,

/s/  
\_\_\_\_\_  
Paul D. Supnik  
9401 Wilshire Boulevard, Suite 1012  
Beverly Hills, California 90212  
Telephone: (310) 859-0100  
Facsimile: (310) 388-5645

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing REGISTRANT'S MOTION TO SUSPEND was served by first class mail, postage prepaid, on this 7<sup>TH</sup> day of October 2008, upon counsel for Petitioner:

Floyd A. Mandell, Esq.  
Lisa K. Shebar, Esq.  
Cathay Y. N. Smith, Esq.  
Katten Muchin Rosenman LLP  
525 West Monroe Street  
Chicago, IL 60661

\_\_\_\_\_  
/s/  
PAUL D. SUPNIK

**EXHIBIT 1 TO  
REGISTRANT'S MOTION TO SUSPEND**

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ROXBURY ENTERTAINMENT  
7  
8

9 UNITED STATES DISTRICT COURT  
10 CENTRAL DISTRICT OF CALIFORNIA

11 CV08-03872

FMC (JW/JX)

12 ROXBURY ENTERTAINMENT, a )  
California corporation, )

13 )  
14 Plaintiff, )

15 vs. )

16 PENTHOUSE MEDIA GROUP, INC., )  
a Nevada corporation; )  
17 PENTHOUSE DIGITAL MEDIA )  
PRODUCTIONS, INC., a )  
18 New York corporation; )  
19 PULSE DISTRIBUTION, LLC, a )  
California LLC; and DOES 1- )  
20 10, inclusive, )

21 Defendants. )  
22 )  
23 )  
24 )  
25 )

Case No.

COMPLAINT FOR:

- (1) VIOLATION OF THE LANHAM ACT
- (2) FEDERAL TRADEMARK INFRINGEMENT
- (3) VIOLATION OF FEDERAL ANTI-DILUTION LAW
- (4) VIOLATION OF STATE ANTI-DILUTION LAW
- (5) COMMON LAW UNFAIR COMPETITION
- (6) STATUTORY UNFAIR COMPETITION (CALIFORNIA BUSINESS & PROFESSIONS CODE §17200)
- (7) UNJUST ENRICHMENT

[DEMAND FOR JURY TRIAL]

2008 JUN 12 PM 4:07  
CLERK U.S. DISTRICT COURT  
CENTRAL DISTRICT OF CALIF.  
LOS ANGELES  
BY \_\_\_\_\_

FILED

1 Plaintiff Roxbury Entertainment ("Roxbury") alleges as  
2 follows:

3 NATURE OF THE ACTION

4 1. This action arises out of Defendants' manufacture,  
5 distribution, marketing and sale of a pornographic film and DVDs  
6 prominently featuring Plaintiff's "Route 66" trademark, a  
7 federally registered and world famous mark ("Roxbury's  
8 Trademark(s)," "Trademark(s)" or "Mark(s)") widely associated  
9 with Plaintiff and Plaintiff's "Route 66" DVDs, television  
10 programs and related products continuously distributed throughout  
11 the United States for the past 48 years by Roxbury and its  
12 predecessors-in-interest. Not only are Defendants Penthouse  
13 Digital Media Productions, Inc. and Penthouse Media Group, Inc.  
14 (collectively "Penthouse") and Pulse Distribution, LLC ("Pulse")  
15 unlawfully and intentionally infringing Roxbury's registered and  
16 common law Trademarks by manufacturing, marketing and selling  
17 DVDs using the exact same mark as Roxbury's Trademark to sell  
18 their pornographic product, but Defendants also are tarnishing  
19 and diluting Roxbury's Trademarks through their use on  
20 Defendants' grossly inferior products, poorly produced  
21 pornography with virtually no storyline, dialogue or acting  
22 (Defendants' "Pornographic Film and DVDs"), products which are  
23 grossly inferior to Roxbury's award winning, classic television  
24 and filmed entertainment.

25 2. Plaintiff's Route 66 Trademark is used and has been  
26 used for more than 48 years to identify the source of the 116  
27 award winning episodes of its highly rated classic television  
28 program which was created and written in the 1960's by Academy

1 Award winner "Sterling Silliphant" (In the Heat of the Night) and  
2 award winning Executive Producer Herbert Leonard (Naked City, Rin  
3 Tin Tin, Route 66) for Sony/Screen Gems Entertainment ("Sony").  
4 Throughout the 1960's, 70's and 80's, Sony and Leonard working  
5 together used the Route 66 Trademark to identify, market and  
6 advertise their television episodes featuring two young and  
7 adventurous travelers, driving their convertible sports car  
8 (Corvette) from American town to town, in search of existential  
9 meaning and their place in American life and culture. The "Route  
10 66" program was unique in American entertainment history,  
11 involving itinerant characters in an anthology of stories, each  
12 one filmed on location and representative of America's people,  
13 history and culture, with the Heartland of America as its  
14 backdrop.

15 3. In the early 1990's, Leonard and Sony created, produced  
16 and distributed a new "Route 66" television program, which they  
17 again advertised, marketed and distributed using the same Route  
18 66 Trademark, also featuring two young men in a convertible  
19 sports car traveling America in search of meaning and adventure.  
20 And throughout the 1990's, Leonard and Sony continued to promote  
21 and distribute their "Route 66" television programs, via  
22 television broadcast and video cassette, throughout the United  
23 States and around the world, creating world-wide audience  
24 recognition for the Route 66 Trademark as the source and origin  
25 of their classic entertainment content.

26 4. In 2001, Leonard, through his wholly-owned company  
27 "Lancer Productions" ("Lancer"), sold and assigned to Plaintiff  
28 Roxbury Entertainment ("Roxbury") all of its rights in and to the



1 "Route 66" television programs and intellectual property,  
2 including Lancer's goodwill and rights in the Route 66 Trademark,  
3 for use in connection with the production and sale of  
4 entertainment content, including but not limited to episodes of  
5 the two prior "Route 66" television programs, as well as any  
6 remakes, sequels and/or any feature film adaptations of the  
7 "Route 66" television programs and related merchandise  
8 (hereafter "Route 66 Products"). Also in 2001, Roxbury began to  
9 develop its own "Route 66" film and television programs, to be  
10 marketed and sold utilizing the Route 66 Trademark made famous by  
11 Roxbury and its predecessors-in-interest.

12 5. In 2004, Roxbury acquired from Sony as the distributor  
13 of "Route 66" all of its remaining rights in and to the "Route  
14 66" television programs and intellectual property rights therein,  
15 including but not limited to the copyrights and trademarks for  
16 "Route 66" and the right to use such copyrights and trademarks  
17 for purposes of producing and distributing remakes, sequels and  
18 feature film adaptations of "Route 66" and/or any other  
19 entertainment products and related merchandise under the  
20 "Route 66" Mark.

21 6. Also commencing in 2004, Roxbury commenced  
22 distribution, licensing and marketing of the existing "Route 66"  
23 television programs, and in 2005, produced, marketed and  
24 distributed the first-ever "Route 66" DVD product, featuring  
25 eleven re-edited episodes of the "Best of Route 66" with special  
26 features about the program, it's stars, its connection to the  
27 Corvette and its place in American entertainment and cultural  
28 history. And in 2005, Roxbury also commenced internet marketing

1 and distribution of its "Route 66" television programs, and  
2 licensed Amazon to distribute the "Route 66" programs through its  
3 website.

4 7. In December of 2006, Roxbury obtained a Federal  
5 Trademark Registration for its Route 66 Trademark for Pre-  
6 Recorded DVDs and Videocassettes (International Class 9, prior US  
7 Classes 21, 23, 26, 36 and 38) which was registered by the US  
8 Patent and Trademark office on December 26, 2006 (Trademark  
9 Registration Certificate No. 3,189,543).

10 8. In January of 2007, Roxbury obtained a Federal Service  
11 Mark Registration for its Route 66 Trademark for Entertainment  
12 Services (International Class 41, prior US Classes 100, 101 and  
13 107) which was registered by the US Patent and Trademark Office  
14 on January 2, 2007 (Trademark Registration Certificate No.  
15 3,194,255).

16 9. And in September of 2007, Roxbury obtained a Federal  
17 Trademark Registration for its Route 66 Trademark for Motion  
18 Picture Films (International Class 9, prior US Classes 21, 23,  
19 26, 36 and 38) which was registered by the US Patent and  
20 Trademark Office on September 11, 2007 (Trademark Registration  
21 Certificate No. 3,291,736).

22 10. For 41 years, Roxbury's predecessors-in-interest  
23 (Lancer and Sony) jointly produced, distributed, advertised and  
24 marketed their Route 66 Products prominently displaying the Route  
25 66 Trademark to identify their source and origin, and for the  
26 past 7 years, Roxbury as the successor-in-interest to all of Sony  
27 and Lancer's rights in and to the Route 66 Products and  
28 Trademark, have continuously advertised, marketed and sold Route

1 66 Products utilizing the Route 66 Mark to identify the source  
2 and origin of those products, and have actively developed and  
3 produced additional entertainment products utilizing the Route 66  
4 Trademark.

5 11. In May of 2008, Roxbury learned of Defendants'  
6 exploitation of the "Route 66" Mark in connection with its  
7 Pornographic Film and DVDs, and on May 12, 2008, Roxbury's  
8 counsel sent a "cease and desist" letter to the General Counsel  
9 for Penthouse, and to the Agent for Service of Process for Pulse,  
10 demanding, inter alia, that Defendants and their co-conspirators  
11 immediately discontinue the manufacture, sale and marketing of  
12 their Pornographic Film and DVDs utilizing the Trademark "Route  
13 66."

14 12. On May 19, 2008, General Counsel for Defendants  
15 Penthouse responded to Roxbury's cease and desist letter with a  
16 refusal to recognize Roxbury's Registered Trademarks in "Route  
17 66" and its outright rejection of Roxbury's demands, contending  
18 that its Pornographic Films and DVDs utilizing the "Route 66"  
19 Mark did not infringe Roxbury's Trademarks, and refusing to  
20 discontinue its manufacture, marketing and sale of its products  
21 prominently displaying the Route 66 Trademark.

22 13. Defendant's General Counsel asserted in his responsive  
23 letter to Plaintiff's counsel that Defendants' Pornographic Film  
24 and DVDs were a "fair use" of Roxbury's Registered and Common Law  
25 Trademarks because, he contended, its use of the Route 66 Mark on  
26 the work's "cover art" was an accurate description of "the  
27 story's theme and subject matter: road related adventures  
28 transpiring on and around Route 66." In fact, nothing could be

1 further from the truth: The content of Defendants' Pornographic  
2 Film and DVDs contains no "story" or "road-related adventure  
3 transpiring on and around Route 66." Rather, the Film is pure  
4 pornography with no more than a few seconds of dialogue (making  
5 no reference to Route 66 or adventure on the open road) preceding  
6 the oral and anal sex between and among various men and women,  
7 the Film's only story, a "story" which all takes place at the  
8 apparently fictitious "Pink Motel" and not on the open road or  
9 anywhere near Route 66.

10 14. In Defendants' Pornographic Film and DVDs, no mention  
11 is made of the Highway "Route 66" by any of the "actors," nor is  
12 there any footage of the actual "Mother Road" or the American  
13 towns, people and culture which make up this iconic Highway.  
14 Defendants' Pornographic Film and DVDs could much more accurately  
15 be called "Sex in and Around the Pink Motel," since it has  
16 absolutely nothing to do with "Route 66" except for Defendants'  
17 blatant exploitation of Roxbury's Route 66 Trademark, on the  
18 cover art, packaging and menu of the DVD, an exploitation  
19 intended to confuse the consuming public as to the affiliation,  
20 source and origin of Defendants' product.

#### 21 22 JURISDICTION AND VENUE

23 15. This action arises under the United States Lanham Act,  
24 15 U.S.C. §1125, et seq. This Court has original jurisdiction  
25 over the subject matter of this action pursuant to 28 U.S.C.  
26 §§1331 and 1338 and 15 U.S.C. §1121(a). The Court has  
27  
28

1 supplemental jurisdiction over Plaintiff's state law claims under  
2 28 U.S.C. §1367(a).

3       16. This Court has personal jurisdiction over each of the  
4 Defendants named in this Complaint, because each Defendant does  
5 sufficient business, has sufficient minimum contacts with  
6 California and this Judicial District, and/or is resident in this  
7 Judicial District, and/or otherwise intentionally avails itself  
8 of the California and Los Angeles markets, through the sale,  
9 marketing, advertising and distribution of its products in this  
10 Judicial District, including the specific product at issue in  
11 this litigation, to render the exercise of jurisdiction over it  
12 by this Court consistent with traditional notions of fair play  
13 and substantial justice.

14       17. Venue in this Judicial District is proper under 28  
15 U.S.C. §§1391(b) and (c) and 1400(a), in that a substantial part  
16 of the events giving rise to Roxbury's claims occurred in this  
17 Judicial District, Defendants' products, including the offending  
18 products at issue in this litigation, are sold in this Judicial  
19 District, and one or more Defendants reside and may be found in  
20 this Judicial District, within the meaning of 28 U.S.C. §§1391(c)  
21 and 1400(a).

22  
23                                   THE PARTIES

24       18. Roxbury is a California corporation based in Santa  
25 Monica, California (steps from the official end of the Route 66  
26 Highway), and is in the business of producing, acquiring and  
27 distributing entertainment content (classic television programs  
28 and motion pictures) for distribution via DVDs, the internet, and

1 theatrical and television exhibition throughout the world.  
2 Roxbury's principal place of business is in Santa Monica,  
3 California, where Roxbury maintains an office and staff who  
4 oversee the development, production, acquisition, marketing,  
5 distribution and protection of its intellectual property,  
6 television programs, DVDs and films, throughout the United States  
7 and the world, and who oversee the licensing and merchandising of  
8 its intellectual properties, including and most significantly its  
9 "Route 66" registered Trademarks and Products.

10 19. Roxbury is informed and believes, and based thereon  
11 alleges, that defendant Penthouse Media Group, Inc., doing  
12 business as "Penthouse," is a corporation organized and existing  
13 under the laws of the State of Nevada, with its principal places  
14 of business in Boca Raton, Florida, and New York, New York.  
15 Roxbury is further informed and believes, and based thereon  
16 alleges, that this Defendant produces, markets and distributes  
17 pornographic DVDs and films throughout the United States,  
18 including in this Judicial District.

19 20. Roxbury is informed and believes, and based thereon  
20 alleges, that defendant Penthouse Digital Media Productions,  
21 Inc., doing business as "Penthouse," is a corporation organized  
22 and existing under the laws of the State of New York, with its  
23 principal places of business in Boca Raton, Florida, and New  
24 York, New York.

25 21. Roxbury is further informed and believes, and based  
26 thereon alleges, that this Defendant produces, markets and  
27 distributes pornographic DVDs and films throughout the United  
28 States, including in this Judicial District.

1       22. Roxbury is informed and believes, and based thereon  
2 alleges, that defendant Pulse Distribution, LLC ("Pulse") is a  
3 California Limited Liability Company with its principal place of  
4 business in Chatsworth, California, is a company organized and  
5 existing under the laws of the State of California and conducts  
6 business in, and markets, distributes and sells pornographic  
7 films and DVDs throughout the United States and including this  
8 Judicial District.

9       23. Roxbury is unaware of the true names and capacities of  
10 the defendants sued herein as Does 1 through 10, inclusive, and  
11 therefore sues these defendants by fictitious names. Roxbury  
12 will seek leave of the Court to amend this Complaint to allege  
13 their true names and capacities when ascertained. Roxbury is  
14 informed and believes, and based thereon alleges, that each  
15 fictitiously named defendant is responsible in some way for the  
16 creation, production, sale and/or distribution of the infringing  
17 products at issue in this Complaint, and is liable to Roxbury  
18 therefor. Penthouse, Pulse and Does 1 through 10 are sometimes  
19 referred to collectively herein as "Defendants."

20       24. Roxbury is informed and believes, and based thereon  
21 alleges, that at all times relevant herein, each of the  
22 Defendants was the agent, servant or employee of each other  
23 Defendant, and at all times relevant herein was acting in whole  
24 or at least in part within the scope of such agency. As such,  
25 each and every Defendant herein is equally responsible in whole  
26 or in part for each and every act alleged herein.

1                   ALLEGATIONS COMMON TO ALL CLAIMS FOR RELIEF

2           25. Plaintiff's Route 66 Products have been widely  
3 distributed in the United States and throughout the world  
4 continuously and pervasively since 1960. In the course of the  
5 production and distribution of these Route 66 Products, Roxbury  
6 and its predecessors in interest and licensees have expended  
7 significant effort advertising, marketing and promoting these  
8 entertainment products under titles bearing the name of, and  
9 prominently featuring, the Route 66 Mark on the products, their  
10 content, their packaging and their marketing and advertising  
11 materials.

12           26. As a result of the success and popularity of its Route  
13 66 Products, Roxbury and its predecessors in interest and  
14 licensees have, for almost five decades, engaged in the business  
15 of merchandising and promoting Route 66 Products throughout the  
16 US and the world.

17           27. Beginning in 2006, Roxbury duly registered the name  
18 "Route 66" as service marks and trademarks in several applicable  
19 entertainment classifications, under the Lanham Act, 15 U.S.C.  
20 §1051 et seq., and Roxbury remains to this date the exclusive  
21 owner of these Registered and Common Law Trademarks for "Route  
22 66" on or in connection with their entertainment products and  
23 services.

24           28. Roxbury and its predecessors-in-interest have developed  
25 an excellent reputation and highly valuable goodwill in the  
26 Route 66 Trademark, and the products, goods and services  
27 featuring that Trademark. Through the consistent and extensive  
28 advertising and widespread distribution and success of Roxbury's



1 Products featuring the Route 66 Trademark, the advertising and  
2 distribution of merchandise featuring the Route 66 Trademark, and  
3 the use of the Route 66 Trademark in national and/or regional  
4 advertising campaigns, a secondary meaning has been created in  
5 the minds of the public throughout the United States, and  
6 throughout the world, by which the Route 66 Trademark has become  
7 strongly identified and associated with Roxbury and Roxbury's  
8 series of television programs, films, DVDs and merchandise  
9 featuring the Route 66 Mark. Roxbury therefore has acquired  
10 common law trademark rights in the Route 66 Trademark in addition  
11 to its federally-registered Route 66 Marks.

12 29. In addition, and also as a result of the extensive  
13 advertising and widespread distribution and success of Roxbury's  
14 Route 66 Products, the advertising and distribution of  
15 merchandise featuring the Route 66 Trademark, and the use of the  
16 Route 66 Trademark in national and/or regional advertising  
17 campaigns, the Route 66 Trademarks are famous throughout the  
18 United States and the world and are immediately recognizable to  
19 and known by the public.

20 30. Roxbury is informed and believes, and based thereon  
21 alleges, that Defendants have exploited Defendants' Pornographic  
22 Film and DVDs, prominently featuring and exploiting the Route 66  
23 Trademark, by without limitation, advertising and distributing  
24 such products in interstate commerce and throughout the United  
25 States, including Los Angeles.

26 31. Roxbury has demanded that Defendants cease selling  
27 Defendants' Pornographic Film and DVDs featuring and exploiting  
28 the Route 66 Trademark, but Defendants have refused to do so.

1        32. Defendants have never sought from Roxbury, nor has  
2 Roxbury ever granted Defendants, permission or consent to  
3 utilize or exploit the Route 66 Trademark on or in connection  
4 with any goods or merchandise or for any purpose whatsoever, or  
5 to authorize others to engage in any of the foregoing activities.

6        33. By designing, manufacturing, reproducing, advertising,  
7 marketing, displaying, selling, distributing and otherwise  
8 exploiting their Pornographic Film and DVDs featuring the Route  
9 66 Trademark, and/or by authorizing or contributing to the  
10 foregoing, Defendants have obtained for themselves a benefit  
11 which is otherwise paid for by others and have obtained valuable  
12 property rights belonging to Roxbury without having paid for  
13 them.

14  
15                    FIRST CLAIM FOR RELIEF

16                    Against All Defendants for Violation of

17                    Section 43(a) of the Lanham Act

18        34. Roxbury Entertainment realleges and incorporates by  
19 this reference the allegations contained in paragraphs 1 through  
20 33, inclusive, as though they were fully set forth herein.

21        35. By, without limitation, designing, manufacturing,  
22 reproducing, importing, advertising, marketing, displaying,  
23 selling, distributing, licensing and otherwise exploiting  
24 Defendants' Pornographic Film and DVDs prominently bearing the  
25 trademark "Route 66" on the product, its packaging and its  
26 marketing and advertising materials, Defendants have created, and  
27 will continue to create, a likelihood of confusion in the  
28 marketplace as to the source of Defendants' Pornographic Film and

1 DVDs, and have falsely created the impression in the minds of the  
2 consuming public that Defendants are somehow associated,  
3 affiliated or connected with Roxbury Entertainment and its Route  
4 66 Products, that Roxbury sponsored or endorsed the merchandise  
5 at issue, and/or that Roxbury approved or authorized Defendants'  
6 use of its Route 66 Trademark on Defendants' Pornographic Film  
7 and DVDs. Such conduct violates Section 43(a) of the Lanham Act,  
8 15 U.S.C. §1125(a).

9 36. As a direct and proximate result of Defendants'  
10 wrongful conduct, Roxbury has been damaged and is entitled to  
11 recover Defendants' wrongfully obtained profits and three times  
12 Roxbury's actual damages, pursuant to 15 U.S.C. §1117(a).

13 37. Defendants' violation of the Lanham Act has caused and  
14 will cause irreparable harm to Roxbury which cannot be fully  
15 compensated by money. Roxbury has no adequate remedy at law.  
16 Therefore, in addition to monetary relief, Roxbury is entitled to  
17 preliminary and permanent injunctive relief preventing Defendants  
18 from continuing to use the Route 66 Trademark on or in connection  
19 with the sale of its Pornographic Film or DVDs, or any  
20 confusingly similar variations, or in connection with any  
21 products, goods or services.

22 38. Defendants engaged in the foregoing conduct knowingly,  
23 willfully and oppressively, intending to appropriate Roxbury's  
24 intellectual property to the detriment of Roxbury and to the  
25 confusion of the public. This constitutes an exceptional case  
26 within the meaning of Section 35 of the Lanham Act, 15 U.S.C.  
27 §1117, for which Roxbury should recover its attorneys' fees and  
28 costs incurred in connection herewith.

1  
2 SECOND CLAIM FOR RELIEF

3 Against All Defendants for Federal Trademark Infringement

4 39. Roxbury realleges and incorporates by this reference  
5 the allegations contained in paragraphs 1 through 38, inclusive,  
6 as though they were fully set forth herein.

7 40. Defendants' unauthorized use of a counterfeit, copy or  
8 precise imitation of Roxbury's Registered Trademarks on and in  
9 connection with Defendants' Pornographic Film and DVDs creates  
10 confusion in the marketplace and constitutes an infringement of  
11 Roxbury's Registered Trademarks in violation of 15 U.S.C. §1114.  
12 Roxbury is informed and believes, and based thereon alleges, that  
13 Defendants' use and exploitation of the Route 66 Mark was  
14 willful, intentional, that Defendants were aware and are aware of  
15 Roxbury's Registered and Common Law Trademarks, and that  
16 Defendants purposefully used Roxbury's Trademarks to trade on  
17 Roxbury's reputation, to cause confusion, mistake and/or  
18 deception, and to take advantage of the goodwill and public  
19 recognition associated with the Route 66 Trademarks for their own  
20 commercial advantage.

21 41. As a direct and proximate result of Defendants'  
22 trademark infringement, Roxbury has been damaged and is entitled  
23 to recover Defendants' wrongfully obtained profits and three  
24 times Roxbury's actual damages, pursuant to 15 U.S.C. §1117(a).

25 42. Defendants' trademark infringement has caused and will  
26 cause irreparable harm to Roxbury which cannot be fully  
27 compensated by money. Roxbury has no adequate remedy at law.  
28 Therefore, in addition to monetary relief, Roxbury is entitled to

1 preliminary and permanent injunctive relief preventing Defendants  
2 from continuing to use Roxbury's Route 66 Trademark, or any  
3 confusingly similar variations, on or in connection with any  
4 products, goods or services.

5 43. Defendants engaged and continue to engage in the  
6 foregoing conduct knowingly, willfully and oppressively,  
7 intending to appropriate Roxbury's intellectual property to the  
8 detriment of Roxbury and to the confusion of the public. This  
9 constitutes an exceptional case within the meaning of Section 35  
10 of the Lanham Act, 15 U.S.C. §1117, for which Roxbury should  
11 recover its attorneys' fees and costs incurred herein.

12  
13 THIRD CLAIM FOR RELIEF

14 Against All Defendants for Violation of  
15 Federal Anti-Dilution Law (15 U.S.C. §1125(c))

16 44. Roxbury realleges and incorporates by this reference  
17 the allegations contained in paragraphs 1 through 43, inclusive,  
18 as though they were fully set forth herein.

19 45. By, without limitation, designing, manufacturing,  
20 reproducing, importing, advertising, marketing, displaying,  
21 selling, distributing, licensing and otherwise exploiting  
22 Defendants' Pornographic Film and DVDs, Defendants have created,  
23 and will continue to create, a likelihood of dilution and  
24 tarnishment of the distinctive and superior quality of Roxbury's  
25 famous Route 66 Trademark and Route 66 Products, because Roxbury  
26 cannot control the quality of Defendants' merchandise or the  
27 manner in which Defendants utilize that Trademark on and in  
28 Defendants' merchandise.

1        46. Defendants' Pornographic Film and DVDs are grossly  
2 inferior products to those of Plaintiff, featuring little or no  
3 dialogue by "actors" who display no apparent acting talent and  
4 are so embarrassed by their performances that they use pseudonyms  
5 to hide their true identities, and contain no storylines or  
6 themes other than the very graphic exhibitions of oral, anal and  
7 violent sex between and among various men and women in a random  
8 fashion.

9        47. Roxbury is informed and believes, and based thereon  
10 alleges, that Defendants' use and exploitation of the Route 66  
11 Trademarks was willful and intentional, that Defendants were and  
12 are aware of Roxbury's Registered and Common Law Trademarks, and  
13 that Defendants purposefully used and continue to use Roxbury's  
14 Trademarks to trade on Roxbury's reputation, to cause confusion,  
15 mistake and/or deception, and to take advantage of the goodwill  
16 and public recognition associated with the Route 66 Trademark and  
17 Products for their own commercial advantage.

18        48. Accordingly, as a direct and proximate result of  
19 Defendants' wrongful conduct, Roxbury has been substantially  
20 damaged and is entitled to recover Defendants' wrongfully  
21 obtained profits and three times Roxbury's actual damages,  
22 pursuant to 15 U.S.C. §1117(a).

23        49. Defendants' violation of the Federal Anti-Dilution Law  
24 has caused and will cause irreparable harm to Roxbury which  
25 cannot be fully compensated by money. Roxbury has no adequate  
26 remedy at law. Therefore, in addition to monetary relief,  
27 Roxbury is entitled to preliminary and permanent injunctive  
28 relief preventing Defendants from continuing to use Roxbury's

1 Route 66 Trademarks, or any confusingly similar variations, on or  
2 in connection with any products, goods or services.

3 50. Defendants engaged and continue to engage in the  
4 foregoing conduct knowingly, willfully and oppressively,  
5 intending to appropriate Roxbury's intellectual property to the  
6 detriment of Roxbury and to the confusion of the public. This  
7 constitutes an exceptional case within the meaning of Section 35  
8 of the Lanham Act, 15 U.S.C. §1117, for which Roxbury should  
9 recover its attorneys' fees and costs incurred herewith.

10  
11 FOURTH CLAIM FOR RELIEF

12 Against All Defendants for Violation

13 of State Anti-Dilution Law

14 (California Business & Professions Code §14330)

15 51. Roxbury realleges and incorporates by this reference  
16 the allegations contained in paragraphs 1 through 50, inclusive,  
17 as though they were fully set forth herein.

18 52. Roxbury's Route 66 Trademark is a strong and well  
19 recognized mark and thus entitled to protection as a "distinctive  
20 mark" under the California Anti-Dilution statute, California  
21 Business and Professions Code §14330.

22 53. By, without limitation, designing, manufacturing,  
23 reproducing, importing, advertising, marketing, displaying,  
24 selling, distributing, licensing and otherwise exploiting  
25 Defendants' Pornographic Film and DVDs, Defendants have created,  
26 and will continue to create, a likelihood of injury to Roxbury's  
27 business reputation and/or dilution of the distinctive quality of  
28 the Route 66 Trademarks, and Roxbury's reputation and products

1 associated therewith, in violation of the California Business  
2 and Professions Code §14330(a).

3 54. As a direct and proximate result of the foregoing  
4 conduct of Defendants, Roxbury has suffered and continues to  
5 suffer monetary damages and is therefore entitled to an award of  
6 such damages in an amount to be proven at trial.

7 55. Defendants' violation of California's Anti-Dilution Law  
8 has caused and will continue to cause irreparable harm to Roxbury  
9 which cannot be fully compensated by money. Roxbury has no  
10 adequate remedy at law. Therefore, in addition to monetary  
11 relief, Roxbury is entitled to preliminary and permanent  
12 injunctive relief preventing Defendants from continuing to use  
13 Roxbury's Route 66 Trademarks, or any confusingly similar  
14 variations, on or in connection with its Pornographic Film and  
15 DVDs and/or any other products, goods or services.

16  
17 FIFTH CLAIM FOR RELIEF

18 Against All Defendants for Common Law Unfair Competition

19 56. Roxbury realleges and incorporates by this reference  
20 the allegations contained in paragraphs 1 through 55, inclusive,  
21 as though they were fully set forth herein.

22 57. By their conduct as alleged above, Defendants have  
23 violated and infringed Roxbury's common law rights in its Route  
24 66 Trademarks, and have otherwise competed unfairly with Roxbury  
25 and Roxbury's authorized licensees in violation of the common law  
26 of the State of California.



1       58. As a direct and proximate result of Defendants'  
2 conduct, Roxbury has suffered and is entitled to monetary damages  
3 in an amount to be proven at trial.

4       59. By their conduct as described above, Defendants have  
5 engaged in outrageous and despicable conduct and have acted with  
6 ill will, malice and oppression toward Roxbury and in conscious  
7 disregard of Roxbury's rights. Roxbury is therefore entitled to  
8 recover, in addition to actual damages, exemplary and punitive  
9 damages under California Civil Code §3294, in an amount  
10 sufficient to punish and make an example of Defendants.

11       60. Defendants' unlawful conduct has caused and continues  
12 to cause irreparable harm to Roxbury which cannot be fully  
13 compensated by money. Roxbury has no adequate remedy at law.  
14 Therefore, in addition to monetary relief, Roxbury is entitled to  
15 preliminary injunctive relief enjoining Defendants from engaging  
16 in further acts of unfair competition.

17  
18                   SIXTH CLAIM FOR RELIEF

19           Against All Defendants for Statutory Unfair Competition

20           (California Business & Professions Code §17200 et seq.)

21       61. Roxbury realleges and incorporates by this reference  
22 the allegations contained in paragraphs 1 through 60, inclusive,  
23 as though they were fully set forth herein.

24       62. By their conduct as described above, Defendants have  
25 intentionally and willfully engaged in unlawful, unfair and  
26 fraudulent methods of competition, and unfair or deceptive acts  
27 or practices in violation of §17200 et seq. of the California  
28 Business and Professions Code.

1       63. Defendants' conduct has caused and will cause  
2 irreparable harm to Roxbury which cannot be fully compensated by  
3 money. Roxbury has no adequate remedy at law. Therefore,  
4 Roxbury is entitled to preliminary and permanent injunctive  
5 relief enjoining Defendants from engaging in further unfair and  
6 deceptive trade practices.

7       64. Roxbury is further entitled to an order pursuant to  
8 §17203 of the California Business and Professions Code restoring  
9 to Roxbury all of its interest in monies that were acquired by  
10 Defendants by means of any unlawful acts or practices hereunder.

11  
12                   SEVENTH CLAIM FOR RELIEF

13                   Against All Defendants for Unjust Enrichment

14       65. Roxbury realleges and incorporates by this reference  
15 the allegations contained in paragraphs 1 through 64, inclusive,  
16 as though they were fully set forth herein.

17       66. By their conduct as alleged above, Defendants have  
18 unjustly retained a benefit to the detriment of Roxbury, and such  
19 benefit violates the fundamental principles of justice, equity  
20 and good conscience.

21       67. Accordingly, Roxbury is entitled to an order requiring  
22 Defendants to disgorge any and all such ill-gotten gains to  
23 Roxbury.

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1           3.     That Defendants be ordered immediately to recall all  
2 copies of Defendants' Pornographic Film and DVDs and all  
3 packaging, masters, discs, artwork, advertising and marketing  
4 materials utilizing the mark "Route 66" in any way, shape or  
5 form.

6           4.     That Defendants, within thirty days after service of  
7 judgment with notice of entry thereof upon it, be required to  
8 file with the Court and serve upon Roxbury's attorneys a written  
9 report under oath setting forth in detail the manner in which  
10 Defendants have complied with the requirements of the injunction  
11 and order.

12           5.     That Defendants be required to account for and pay over  
13 to Roxbury their profits plus the actual compensatory damages  
14 sustained by Roxbury by reason of Defendants' unlawful conduct  
15 alleged herein, and that the amount of recovery be increased up  
16 to three times actual damages suffered by Roxbury, as provided by  
17 15 U.S.C. §1117(a) (3) .

18           6.     For an order pursuant to §17203 of the California  
19 Business and Professions Code restoring to Roxbury all of its  
20 interest in monies that were acquired by Defendants by means of  
21 their unlawful acts and practices hereunder.

22           7.     For an order requiring Defendants to disgorge any and  
23 all gains or benefits conferred upon Defendants as a result of  
24 their violations of law.

25           8.     For punitive and exemplary damages sufficient to punish  
26 Defendants and deter their wrongful conduct in the future.

27           9.     For Roxbury's attorneys' fees and costs incurred  
28 herewith.

- 1        10. For pre-judgment interest at the maximum legal rate.  
2        11. For such other and further relief as the Court may deem  
3 just and proper.

4 Dated: June 12, 2008

5 LAW OFFICES OF KIRK M. HALLAM  
6  
7

8 By: 

9 KIRK M. HALLAM  
10 Attorney for Plaintiff  
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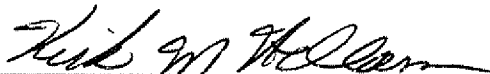
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DEMAND FOR JURY TRIAL

Plaintiff Roxbury hereby demands a jury trial of all issues so triable, as provided by Rule 38(a) of the Federal Rules of Civil Procedure.

Dated: June 12, 2008

LAW OFFICES OF KIRK M. HALLAM

By:   
KIRK M. HALLAM  
Attorney for Plaintiff

**UNITED STATES DISTRICT COURT, CENTRAL DISTRICT OF CALIFORNIA  
CIVIL COVER SHEET**

**I (a) PLAINTIFFS** (Check box if you are representing yourself ☐)  
ROXBURY ENTERTAINMENT, a California corporation

**DEFENDANTS**  
PENTHOUSE MEDIA GROUP, INC., a Nevada corporation  
PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC., a New York corporation  
PULSE DISTRIBUTION, LLC, a California Limited Liability Company

**(b) Attorneys** (Firm Name, Address and Telephone Number. If you are representing yourself, provide same.)

KIRK M. HALLAM (310) 393-4006  
LAW OFFICES OF KIRK M. HALLAM, 201 WILSHIRE BLVD.,  
2ND FLOOR, SANTA MONICA, CA 90401

Attorneys (If Known)

**II. BASIS OF JURISDICTION** (Place an X in one box only.)

- ☐ 1 U.S. Government Plaintiff ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

**III. CITIZENSHIP OF PRINCIPAL PARTIES - For Diversity Cases Only**  
(Place an X in one box for plaintiff and one for defendant.)

	PTF	DEF		PTF	DEF
Citizen of This State	<input type="checkbox"/> 1	<input type="checkbox"/> 1	Incorporated or Principal Place of Business in this State	<input type="checkbox"/> 4	<input type="checkbox"/> 4
Citizen of Another State	<input type="checkbox"/> 2	<input type="checkbox"/> 2	Incorporated and Principal Place of Business in Another State	<input type="checkbox"/> 5	<input type="checkbox"/> 5
Citizen or Subject of a Foreign Country	<input type="checkbox"/> 3	<input type="checkbox"/> 3	Foreign Nation	<input type="checkbox"/> 6	<input type="checkbox"/> 6

**IV. ORIGIN** (Place an X in one box only.)

- ☒ 1 Original Proceeding ☐ 2 Removed from State Court ☐ 3 Remanded from Appellate Court ☐ 4 Reinstated or Reopened ☐ 5 Transferred from another district (specify): ☐ 6 Multi-District Litigation ☐ 7 Appeal to District Judge from Magistrate Judge

**V. REQUESTED IN COMPLAINT: JURY DEMAND:** ☒ Yes ☐ No (Check 'Yes' only if demanded in complaint.)

according to proof,

**CLASS ACTION** under F.R.C.P. 23: ☐ Yes ☐ No

☒ **MONEY DEMANDED IN COMPLAINT:** \$ treble damages, attorneys' fees

**VI. CAUSE OF ACTION** (Cite the U.S. Civil Statute under which you are filing and write a brief statement of cause. Do not cite jurisdictional statutes unless diversity.)

Action for infringement and dilution of Registered and Common Law Trademark under the Lanham Act, 15 U.S.C. §1125, et seq.

**VII. NATURE OF SUIT** (Place an X in one box only.)

OTHER STATUTES	CONTRACT	TORTS PERSONAL INJURY	TORTS PERSONAL PROPERTY	PRISONER PETITIONS	LABOR
<input type="checkbox"/> 400 State Reapportionment	<input type="checkbox"/> 110 Insurance	<input type="checkbox"/> 310 Airplane	<input type="checkbox"/> 370 Other Fraud	<input type="checkbox"/> 510 Motions to Vacate Sentence	<input type="checkbox"/> 710 Fair Labor Standards Act
<input type="checkbox"/> 410 Antitrust	<input type="checkbox"/> 120 Marine	<input type="checkbox"/> 315 Airplane Product Liability	<input type="checkbox"/> 371 Truth in Lending	<input type="checkbox"/> 530 Habeas Corpus General	<input type="checkbox"/> 720 Labor/Mgmt. Relations
<input type="checkbox"/> 430 Banks and Banking	<input type="checkbox"/> 130 Miller Act	<input type="checkbox"/> 320 Assault, Libel & Slander	<input type="checkbox"/> 380 Other Personal Property Damage	<input type="checkbox"/> 535 Death Penalty	<input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act
<input type="checkbox"/> 450 Commerce/ICC Rates/etc.	<input type="checkbox"/> 140 Negotiable Instrument	<input type="checkbox"/> 330 Fed. Employers' Liability	<input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 540 Mandamus/Other	<input type="checkbox"/> 740 Railway Labor Act
<input type="checkbox"/> 460 Deportation	<input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment	<input type="checkbox"/> 340 Marine	<b>BANKRUPTCY</b>	<input type="checkbox"/> 550 Civil Rights	<input type="checkbox"/> 790 Other Labor Litigation
<input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations	<input type="checkbox"/> 151 Medicare Act	<input type="checkbox"/> 345 Marine Product Liability	<input type="checkbox"/> 422 Appeal 28 USC 158	<input type="checkbox"/> 555 Prison Condition	<input type="checkbox"/> 791 Empl. Ret. Inc. Security Act
<input type="checkbox"/> 480 Consumer Credit	<input type="checkbox"/> 152 Recovery of Defaulted Student Loan (Excl. Veterans)	<input type="checkbox"/> 350 Motor Vehicle	<input type="checkbox"/> 423 Withdrawal 28 USC 157	<b>FORFEITURE / PENALTY</b>	<b>PROPERTY RIGHTS</b>
<input type="checkbox"/> 490 Cable/Sat TV	<input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits	<input type="checkbox"/> 355 Motor Vehicle Product Liability	<b>CIVIL RIGHTS</b>	<input type="checkbox"/> 610 Agriculture	<input type="checkbox"/> 820 Copyrights
<input type="checkbox"/> 810 Selective Service	<input type="checkbox"/> 160 Stockholders' Suits	<input type="checkbox"/> 360 Other Personal Injury	<input type="checkbox"/> 441 Voting	<input type="checkbox"/> 620 Other Food & Drug	<input type="checkbox"/> 830 Patent
<input type="checkbox"/> 850 Securities/Commodities/Exchange	<input type="checkbox"/> 190 Other Contract	<input type="checkbox"/> 362 Personal Injury-Med Malpractice	<input type="checkbox"/> 442 Employment	<input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881	<input checked="" type="checkbox"/> 840 Trademark
<input type="checkbox"/> 875 Customer Challenge 12 USC 3410	<input type="checkbox"/> 195 Contract Product Liability	<input type="checkbox"/> 365 Personal Injury-Product Liability	<input type="checkbox"/> 443 Housing/Accommodations	<input type="checkbox"/> 630 Liquor Laws	<b>SOCIAL SECURITY</b>
<input type="checkbox"/> 890 Other Statutory Actions	<input type="checkbox"/> 196 Franchise	<input type="checkbox"/> 368 Asbestos Personal Injury Product Liability	<input type="checkbox"/> 444 Welfare	<input type="checkbox"/> 640 R.R. & Truck	<input type="checkbox"/> 861 HIA (1395ff)
<input type="checkbox"/> 891 Agricultural Act	<b>REAL PROPERTY</b>	<b>IMMIGRATION</b>	<input type="checkbox"/> 445 American with Disabilities - Employment	<input type="checkbox"/> 650 Airline Regs	<input type="checkbox"/> 862 Black Lung (923)
<input type="checkbox"/> 892 Economic Stabilization Act	<input type="checkbox"/> 210 Land Condemnation	<input type="checkbox"/> 462 Naturalization Application	<input type="checkbox"/> 446 American with Disabilities - Other	<input type="checkbox"/> 660 Occupational Safety/Health	<input type="checkbox"/> 863 DIWC/DIWW (405(g))
<input type="checkbox"/> 893 Environmental Matters	<input type="checkbox"/> 220 Foreclosure	<input type="checkbox"/> 463 Habeas Corpus-Alien Detainee	<input type="checkbox"/> 440 Other Civil Rights	<input type="checkbox"/> 690 Other	<input type="checkbox"/> 864 SSID Title XVI
<input type="checkbox"/> 894 Energy Allocation Act	<input type="checkbox"/> 230 Rent Lease & Ejectment	<input type="checkbox"/> 465 Other Immigration Actions			<input type="checkbox"/> 865 RSI (405(g))
<input type="checkbox"/> 895 Freedom of Info. Act	<input type="checkbox"/> 240 Torts to Land				<b>FEDERAL TAX SUITS</b>
<input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice	<input type="checkbox"/> 245 Tort Product Liability				<input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant)
<input type="checkbox"/> 950 Constitutionality of State Statutes	<input type="checkbox"/> 290 All Other Real Property				<input type="checkbox"/> 871 IRS-Third Party 26 USC 7609

**FOR OFFICE USE ONLY:** Case Number: \_\_\_\_\_

**AFTER COMPLETING THE FRONT SIDE OF FORM CV-71, COMPLETE THE INFORMATION REQUESTED BELOW.**

**UNITED STATES DISTRICT COURT, CENTRAL DISTRICT OF CALIFORNIA**  
**CIVIL COVER SHEET**

**VIII(a). IDENTICAL CASES:** Has this action been previously filed in this court and dismissed, remanded or closed? ☒ No ☐ Yes  
If yes, list case number(s): \_\_\_\_\_

**VIII(b). RELATED CASES:** Have any cases been previously filed in this court that are related to the present case? ☒ No ☐ Yes  
If yes, list case number(s): \_\_\_\_\_

**Civil cases are deemed related if a previously filed case and the present case:**

- (Check all boxes that apply) ☐ A. Arise from the same or closely related transactions, happenings, or events; or  
☐ B. Call for determination of the same or substantially related or similar questions of law and fact; or  
☐ C. For other reasons would entail substantial duplication of labor if heard by different judges; or  
☐ D. Involve the same patent, trademark or copyright, and one of the factors identified above in a, b or c also is present.

**IX. VENUE:** (When completing the following information, use an additional sheet if necessary.)

- (a) List the County in this District; California County outside of this District; State if other than California; or Foreign Country, in which **EACH** named plaintiff resides.  
☐ Check here if the government, its agencies or employees is a named plaintiff. If this box is checked, go to item (b).

County in this District:*	California County outside of this District; State, if other than California; or Foreign Country
ROXBURY ENTERTAINMENT - LOS ANGELES COUNTY	

- (b) List the County in this District; California County outside of this District; State if other than California; or Foreign Country, in which **EACH** named defendant resides.  
☐ Check here if the government, its agencies or employees is a named defendant. If this box is checked, go to item (c).

County in this District:*	California County outside of this District; State, if other than California; or Foreign Country
PULSE DISTRIBUTION, LLC - LOS ANGELES COUNTY	PENTHOUSE MEDIA GROUP, INC., Nevada PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC., New York

- (c) List the County in this District; California County outside of this District; State if other than California; or Foreign Country, in which **EACH** claim arose.  
**Note: In land condemnation cases, use the location of the tract of land involved.**

County in this District:*	California County outside of this District; State, if other than California; or Foreign Country
EACH CLAIM AROSE IN LOS ANGELES COUNTY	

\* Los Angeles, Orange, San Bernardino, Riverside, Ventura, Santa Barbara, or San Luis Obispo Counties

**Note:** In land condemnation cases, use the location of the tract of land involved

X. SIGNATURE OF ATTORNEY (OR PRO PER): *Rich M. Walden* Date JUNE 12, 2008

**Notice to Counsel/Parties:** The CV-71 (JS-44) Civil Cover Sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law. This form, approved by the Judicial Conference of the United States in September 1974, is required pursuant to Local Rule 3-1 is not filed but is used by the Clerk of the Court for the purpose of statistics, venue and initiating the civil docket sheet. (For more detailed instructions, see separate instructions sheet.)

Key to Statistical codes relating to Social Security Cases:

Nature of Suit Code	Abbreviation	Substantive Statement of Cause of Action
861	HIA	All claims for health insurance benefits (Medicare) under Title 18, Part A, of the Social Security Act, as amended. Also, include claims by hospitals, skilled nursing facilities, etc., for certification as providers of services under the program. (42 U.S.C. 1935FF(b))
862	BL	All claims for "Black Lung" benefits under Title 4, Part B, of the Federal Coal Mine Health and Safety Act of 1969. (30 U.S.C. 923)
863	DIWC	All claims filed by insured workers for disability insurance benefits under Title 2 of the Social Security Act, as amended; plus all claims filed for child's insurance benefits based on disability. (42 U.S.C. 405(g))
863	DIWW	All claims filed for widows or widowers insurance benefits based on disability under Title 2 of the Social Security Act, as amended. (42 U.S.C. 405(g))
864	SSID	All claims for supplemental security income payments based upon disability filed under Title 16 of the Social Security Act, as amended.
865	RSI	All claims for retirement (old age) and survivors benefits under Title 2 of the Social Security Act, as amended. (42 U.S.C. (g))



NAME, ADDRESS & TELEPHONE NUMBER OF ATTORNEY(S) FOR OR, PLAINTIFF OR  
DEFENDANT IF PLAINTIFF OR DEFENDANT IS PRO PER

KIRK M. HALLAM (CSB 108975)  
LAW OFFICES OF KIRK M. HALLAM  
201 WILSHIRE BOULEVARD, 2ND FL  
SANTA MONICA, CA 90401  
TEL: 310-393-4006  
EMAIL: KMHallam@aol.com

ATTORNEYS FOR: plaintiff

2008 JUN 12 PM 4:07  
CLERK U.S. DISTRICT COURT  
CENTRAL DIST. OF CALIF.  
LOS ANGELES

FILED

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

ROXBURY ENTERTAINMENT, a California  
corporation

Plaintiff(s),

v.

PENTHOUSE MEDIA GROUP, INC., a Nevada  
corporation; PENTHOUSE DIGITAL MEDIA  
PRODUCTIONS., etc., et al.

Defendant(s)

CASE NUMBER

CV 08-03872 FMC

(UWJx)

CERTIFICATION AND NOTICE  
OF INTERESTED PARTIES  
(Local Rule 7.1-1)

TO: THE COURT AND ALL PARTIES APPEARING OF RECORD:

The undersigned, counsel of record for Plaintiff Roxbury Entertainment  
(or party appearing in pro per), certifies that the following listed party (or parties) has (have) a direct, pecuniary  
interest in the outcome of this case. These representations are made to enable the Court to evaluate possible  
disqualification or recusal. (Use additional sheet if necessary.)

PARTY

CONNECTION

(List the names of all such parties and identify their connection and interest.)

PENTHOUSE MEDIA GROUP, INC.  
PENTHOUSE DIGITAL MEDIA PRODUCTION, INC.  
PULSE DISTRIBUTION, LLC  
ROXBURY ENTERTAINMENT

DEFENDANT  
DEFENDANT  
DEFENDANT  
PLAINTIFF

6/12/08

Date

Sign

*Kirk M Hallam*

*Roxbury Entertainment*

Attorney of record for or party appearing in pro per

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

ROXBURY ENTERTAINMENT, a California  
corporation,

PLAINTIFF(S)

v.

PENTHOUSE MEDIA GROUP, INC., a Nevada  
corporation; PULSE DISTRIBUTION, a California  
Limited Liability Company; and DOES 1-10,  
inclusive,

DEFENDANT(S).

CASE NUMBER

CV 08-03872 FMC (JWJx)

SUMMONS

TO: DEFENDANT(S): \_\_\_\_\_

A lawsuit has been filed against you.

Within \_\_\_\_\_ days after service of this summons on you (not counting the day you received it), you must serve on the plaintiff an answer to the attached ☒ complaint ☐ \_\_\_\_\_ amended complaint ☐ counterclaim ☐ cross-claim or a motion under Rule 12 of the Federal Rules of Civil Procedure. The answer or motion must be served on the plaintiff's attorney, KIRK M. HALLAM, whose address is 201 WILSHIRE BLVD., 2ND FLOOR, SANTA MONICA, CA 90401. If you fail to do so, judgment by default will be entered against you for the relief demanded in the complaint. You also must file your answer or motion with the court.

Dated: \_\_\_\_\_

JUN 12 2008

Clerk, U.S. District Court

By: \_\_\_\_\_

Deputy Clerk

(Seal of the Court)

[Use 60 days if the defendant is the United States or a United States agency, or is an officer or employee of the United States. Allowed 60 days by Rule 12(a)(3)].

**UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA**

**NOTICE OF ASSIGNMENT TO UNITED STATES MAGISTRATE JUDGE FOR DISCOVERY**

This case has been assigned to District Judge Florence-Marie Cooper and the assigned discovery Magistrate Judge is Jeffrey W. Johnson.

The case number on all documents filed with the Court should read as follows:

**CV08- 3872 FMC (JWJx)**

Pursuant to General Order 05-07 of the United States District Court for the Central District of California, the Magistrate Judge has been designated to hear discovery related motions.

All discovery related motions should be noticed on the calendar of the Magistrate Judge

===== :  
**NOTICE TO COUNSEL**

*A copy of this notice must be served with the summons and complaint on all defendants (if a removal action is filed, a copy of this notice must be served on all plaintiffs).*

Subsequent documents must be filed at the following location:

☒ **Western Division**  
312 N. Spring St., Rm. G-8  
Los Angeles, CA 90012

☐ **Southern Division**  
411 West Fourth St., Rm. 1-053  
Santa Ana, CA 92701-4516

☐ **Eastern Division**  
3470 Twelfth St., Rm. 134  
Riverside, CA 92501

Failure to file at the proper location will result in your documents being returned to you.

<b>TO:</b> Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	<b>REPORT ON THE          FILING OR DETERMINATION OF AN          ACTION REGARDING A PATENT OR          TRADEMARK</b>
--	--

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court \_\_\_\_\_ on the following ☐ Patents or ☐ Trademarks:

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
PLAINTIFF		DEFENDANT
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
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CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Director    Copy 3—Upon termination of action, mail this copy to Director  
 Copy 2—Upon filing document adding patent(s), mail this copy to Director    Copy 4—Case file copy

FILED

2008 JUN 12 PM 4:13  
CLERK U.S. DISTRICT COURT  
CENTRAL DIST. OF CALIF.  
LOS ANGELES

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

ROXBURY ENTERTAINMENT

PLAINTIFF(S)

V.

PENTHOUSE MEDIA GROUP, INC.,  
ET AL.

DEFENDANT(S).

CASE NUMBER

CV08- 3872 FMC (JWJx)

NOTICE TO PARTIES OF ADR PILOT  
PROGRAM

Dear Counsel,

The district judge to whom the above-referenced case has been assigned is participating in an ADR Pilot Program. All counsel of record are directed to jointly complete the attached ADR Pilot Program Questionnaire, and plaintiff's counsel (or defendant in a removal case) is directed to concurrently file the Questionnaire with the report required under Federal Rules of Civil Procedure 26(f).

Clerk, U.S. District Court

06/12/08

Date

By: LHORN

Deputy Clerk

**UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA**

**ROXBURY ENTERTAINMENT**

PLAINTIFF(S)

V.

**PENTHOUSE MEDIA GROUP, INC., ET AL.**

DEFENDANT(S).

CASE NUMBER

**CV08- 3872 FMC (JWJx)**

**ADR PILOT PROGRAM QUESTIONNAIRE**

(1) What, if any, discovery do the parties believe is essential in order to prepare adequately for a settlement conference or mediation? Please outline with specificity the type(s) of discovery and proposed completion date(s). Please outline any areas of disagreement in this regard. Your designations do not limit the discovery that you will be able to take in the event this case does not settle.

(2) What are the damage amounts being claimed by each plaintiff? Identify the categories of damage claimed [e.g., lost profits, medical expenses (past and future), lost wages (past and future), emotional distress, damage to reputation, etc.] and the portion of the total damages claimed attributed to each category.

(3) Do the parties agree to utilize a private mediator in lieu of the court's ADR Pilot Program?

Yes ☐ No ☐

(4) If this case is in category civil rights - employment (442), check all boxes that describe the legal bases of plaintiff claim(s).

☐ Title VII

☐ Age Discrimination

☐ 42 U.S.C. section 1983

☐ California Fair Employment and Housing Act

☐ Americans with Disabilities Act of 1990

☐ Rehabilitation Act

☐ Other \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

I hereby certify that all parties have discussed and agree that the above-mentioned responses are true and correct.

\_\_\_\_\_  
Date

\_\_\_\_\_  
Attorney for Plaintiff (Signature)

\_\_\_\_\_  
Attorney for Plaintiff (Please print full name)

\_\_\_\_\_  
Date

\_\_\_\_\_  
Attorney for Defendant (Signature)

\_\_\_\_\_  
Attorney for Defendant (Please print full name)

**EXHIBIT 2 TO  
REGISTRANT'S MOTION TO SUSPEND**



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Attorneys for Defendants

**UNITED STATES DISTRICT COURT**  
**CENTRAL DISTRICT OF CALIFORNIA**

ROXBURY ENTERTAINMENT, a  
California corporation,  
  
Plaintiff,

vs.

PENTHOUSE MEDIA GROUP, INC., a  
Nevada corporation; PENTHOUSE  
DIGITAL MEDIA PRODUCTIONS,  
INC., a New York corporation; PULSE  
DISTRIBUTION, LLC, a California  
LLC; and 1-10, inclusive,  
  
Defendants.

Case No. CV 08-03872

**DEFENDANTS' ANSWER AND  
AFFIRMATIVE DEFENSES**

Defendants Penthouse Media Group Inc., a Nevada corporation, n/k/a  
FriendFinder Networks Inc., Penthouse Digital Media Productions, Inc., a New York  
Corporation, and Pulse Distribution, LLC, a California corporation (collectively

**DEFENDANTS' ANSWER AND AFFIRMATIVE DEFENSES**

1 “Defendants”) hereby provide their Answer and Affirmative Defenses to Plaintiff’s  
 2 Roxbury Entertainment (“Plaintiff”) Complaint, as follows:

### 3 NATURE OF THE ACTION

#### 4 Complaint Paragraph No. 1

5 This action arises out of Defendants’ manufacture, distribution,  
 6 marketing and sale of a pornographic film and DVDs prominently  
 7 featuring Plaintiff’s “Route 66” trademark, a federally registered and  
 8 world famous mark (“Roxbury’s Trademark(s),” “Trademark(s)” or  
 9 “Mark(s)”) widely associated with Plaintiff and Plaintiff’s “Route 66”  
 10 DVDs, television programs and related products continuously  
 11 distributed throughout the United States for the past 48 years by  
 12 Roxbury and its predecessors-in-interest. Not only are Defendants  
 13 Penthouse Digital Media Productions, Inc. and Penthouse Media Group,  
 14 Inc. (collectively “Penthouse”) and Pulse Distribution, LLC (“Pulse”)  
 15 unlawfully and intentionally infringing Roxbury’s registered and  
 16 common law Trademarks by manufacturing, marketing and selling  
 17 DVDs using the exact same mark as Roxbury’s Trademark to sell their  
 18 pornographic product, but Defendants also are tarnishing and diluting  
 19 Roxbury’s Trademarks through their use on Defendants’ grossly inferior  
 20 products, poorly produced pornography with virtually no storyline,  
 21 dialogue or acting (Defendants’ “Pornographic Film and DVDs”),  
 22 products which are grossly inferior to Roxbury’s award winning, classic  
 23 television and filmed entertainment.

#### 24 Answer to Paragraph No. 1

25 Defendants admit that they distributed, marketed and sold limited numbers of  
 26 an adult entertainment film and DVD which employed the descriptive, historic, and  
 27 widely used term “Route 66” in its title, combined with the world-famous  
 28 PENTHOUSE trademark. Defendants affirmatively aver that such use was fair use as  
 it has artistic relevance to the content of the underlying work. Defendants are without  
 sufficient knowledge or information concerning the quality of Plaintiff’s products, and  
 the alleged forty-eight (48) years of continuous use claimed by Plaintiff, and therefore,  
 deny such allegations. Defendants deny each and every remaining allegation in  
 Paragraph 1.

#### 29 Complaint Paragraph No. 2

30 Plaintiff’s Route 66 Trademark is used and has been used for  
 more than 48 years to identify the source of the 116 award winning  
 episodes of its highly rated classic television program which was created

1 and written in the 1960's by Academy Award winner "Sterling  
2 Silliphant" (In the Heat of the Night) and award winning Executive  
3 Producer Herbert Leonard (Naked City, Rin Tin Tin, Route 66) for  
4 Sony/Screen Gems Entertainment ("Sony"). Throughout the 1960's,  
5 70's and 80's, Sony and Leonard working together used the Route 66  
6 Trademark to identify, market and advertise their television episodes  
7 featuring two young and adventurous travelers, driving their convertible  
8 sports car (Corvette) from American town to town, in search of  
9 existential meaning and their place in American life and culture. The  
10 "Route 66" program was unique in American entertainment history,  
11 involving itinerant characters in an anthology of stories, each one filmed  
12 on location and representative of America's people, history and culture,  
13 with the Heartland of America as its backdrop.

### 8 Answer to Paragraph No. 2

9 Defendants admit the term "Route 66" has historic and cultural relevance in  
10 American culture. Defendants deny that "Route 66" as a television program is unique  
11 in American entertainment history. Defendants are without sufficient knowledge or  
12 information to form a belief as to the truth of the remaining allegations in Paragraph 2,  
13 and therefore, deny each and every remaining allegation in Paragraph 2.

### 14 Complaint Paragraph No. 3

15 In the early 1990's, Leonard and Sony created, produced and  
16 distributed a new "Route 66" television program, which they again  
17 advertised, marketed and distributed using the same Route 66  
18 Trademark, also featuring two young men in a convertible sports car  
19 traveling America in search of meaning and adventure. And throughout  
20 the 1990's, Leonard and Sony continued to promote and distribute their  
21 "Route 66" television programs, via television broadcast and video  
22 cassette, throughout the United States and around the world, creating  
23 world-wide audience recognition for the Route 66 Trademark as the  
24 source and origin of their classic entertainment content.

### 25 Answer to Paragraph No. 3

26 Defendants deny that the highly diluted and descriptive term "Route 66" is  
27 recognized worldwide or throughout the United States as a trademark owned by  
28 Plaintiff. Defendants are without sufficient knowledge or information to form a belief  
as to the truth of the remaining allegations in Paragraph 3, and therefore deny each  
and every remaining allegation in Paragraph 3.

**Complaint Paragraph No. 4**

In 2001, Leonard, through his wholly-owned company "Lancer Productions" ("Lancer"), sold and assigned to Plaintiff Roxbury Entertainment ("Roxbury") all of its rights in and to the "Route 66" television programs and intellectual property, including Lancer's goodwill and rights in the Route 66 Trademark, for use in connection with the production and sale of entertainment content, including but not limited to episodes of the two prior "Route 66" television programs, as well as any remakes, sequels and/or any feature film adaptations of the "Route 66" television programs and related merchandise (hereafter "Route 66 Products"). Also in 2001, Roxbury began to develop its own "Route 66" film and television programs, to be marketed and sold utilizing the Route 66 Trademark made famous by Roxbury and its predecessors-in-interest.

**Answer to Paragraph No. 4**

Defendants deny that "Route 66" is a trademark made famous by Roxbury and/or by its predecessors-in-interest. Defendants are without sufficient knowledge and information to form a belief as to the truth of the remaining allegations in Paragraph 4, and therefore, deny each and every remaining allegation in Paragraph 4.

**Complaint Paragraph No. 5**

In 2004, Roxbury acquired from Sony as the distributor of "Route 66" all of its remaining rights in and to the "Route 66" television programs and intellectual property rights therein, including but not limited to the copyrights and trademarks for "Route 66" and the right to use such copyrights and trademarks for purposes of producing and distributing remakes, sequels and feature film adaptations of "Route 66" and/or any other entertainment products and related merchandise under the "Route 66" Mark.

**Answer to Paragraph No. 5**

Defendants are without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 5, and therefore deny each and every allegation in Paragraph 5.

**Complaint Paragraph No. 6**

Also commencing in 2004, Roxbury commenced distribution, licensing and marketing of the existing "Route 66" television programs, and in 2005, produced, marketed and distributed the first-ever "Route 66" DVD product, featuring eleven re-edited episodes of the "Best of Route 66" with special features about the program, it's stars, its connection to the Corvette and its place in American entertainment and cultural history. And in 2005, Roxbury also commenced internet marketing and distribution of its "Route 66" television programs, and licensed Amazon to distribute the "Route 66" programs through its website.

**Answer to Paragraph No. 6**

Defendants are without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 6, and therefore deny each and every allegation in Paragraph 6.

**Complaint Paragraph No. 7**

In December of 2006, Roxbury obtained a Federal Trademark Registration for its Route 66 Trademark for Pre-Recorded DVDs and Videocassettes (International Class 9, prior US Classes 21, 23, 26, 36 and 38) which was registered by the US Patent and Trademark office on December 26, 2006 (Trademark Registration Certificate No. 3,189,543).

**Answer to Paragraph No. 7**

Defendants are without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 7, and therefore deny each and every allegation in Paragraph 7.

**Complaint Paragraph No. 8**

In January of 2007, Roxbury obtained a Federal Service Mark Registration for its Route 66 Trademark for Entertainment Services (International Class 41, prior US Classes 100, 101 and 107) which was registered by the US Patent and Trademark Office on January 2, 2007 (Trademark Registration Certificate No. 3,194,255).

**Answer to Paragraph No. 8**

Defendants are without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 8, and therefore deny each and every allegation in Paragraph 8.

**Complaint Paragraph No. 9**

And in September of 2007, Roxbury obtained a Federal Trademark Registration for its Route 66 Trademark for Motion Picture Films (International Class 9, prior US Classes 21, 23, 26, 36 and 38) which was registered by the US Patent and Trademark Office on September 11, 2007 (Trademark Registration Certificate No. 3,291,736).

**Answer to Paragraph No. 9**

Defendants are without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 9, and therefore deny each and every allegation in Paragraph 9.

**Complaint Paragraph No. 10**

For 41 years, Roxbury's predecessors-in-interest (Lancer and Sony) jointly produced, distributed, advertised and marketed their Route 66 Products prominently displaying the Route 66 Trademark to identify their source and origin, and for the past 7 years, Roxbury as the successor-in-interest to all of Sony and Lancer's rights in and to the Route 66 Products and Trademark, have continuously advertised, marketed and sold Route 66 Products utilizing the Route 66 Mark to identify the source and origin of those products, and have actively developed and produced additional entertainment products utilizing the Route 66 Trademark.

**Answer to Paragraph No. 10**

Defendants are without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 10, and therefore deny each and every allegation in Paragraph 10.

**Complaint Paragraph No. 11**

In May of 2008, Roxbury learned of Defendants' exploitation of the "Route 66" Mark in connection with its Pornographic Film and DVDs, and on May 12, 2008, Roxbury's counsel sent a "cease and desist" letter to the General Counsel for Penthouse, and to the Agent for Service of Process for Pulse, demanding, inter alia, that Defendants and their co-conspirators immediately discontinue the manufacture, sale and marketing of their Pornographic Film and DVDs utilizing the Trademark "Route 66."

**Answer to Paragraph No. 11**

Defendants admit that Roxbury's counsel sent a "cease and desist" letter to the General Counsel for Penthouse and to the Agent for Service of Process for Pulse demanding that the Defendants immediately cease and desist use of "Route 66" as part of a title for their film and DVD. Defendants are without knowledge as to when Roxbury learned of Defendants' use of "Route 66" in connection with their title, and therefore deny that allegation. Defendants deny each and every remaining allegation in Paragraph 11.

**Complaint Paragraph No. 12**

On May 19, 2008, General Counsel for Defendants Penthouse responded to Roxbury's cease and desist letter with a refusal to recognize Roxbury's Registered Trademarks in "Route 66" and its outright rejection of Roxbury's demands, contending that its Pornographic Films and DVDs utilizing the "Route 66" Mark did not infringe Roxbury's Trademarks, and refusing to discontinue its manufacture, marketing and sale of its products prominently displaying the Route 66 Trademark.

**Answer to Paragraph No. 12**

Defendants admit that in a letter dated May 19, 2008, General Counsel for Defendants Penthouse responded to Roxbury's cease and desist letter and denied infringement. Defendants deny each and every remaining allegation in Paragraph 12.

**Complaint Paragraph No. 13**

Defendant's General Counsel asserted in his responsive letter to Plaintiff's counsel that Defendants' Pornographic Film and DVDs were a "fair use" of Roxbury's Registered and Common Law Trademarks because, he contended, its use of the Route 66 Mark on the work's "cover art" was an accurate description of "the story's theme and subject matter: road related adventures transpiring on and around Route 66." In fact, nothing could be further from the truth: The content of Defendants' Pornographic Film and DVDs contains no "story" or "road-related adventure transpiring on and around Route 66." Rather, the Film is pure pornography with no more than a few seconds of dialogue (making no reference to Route 66 or adventure on the open road) preceding the oral and anal sex between and among various men and women, the Film's only story, a "story" which all takes place at the apparently fictitious "Pink Motel" and not on the open road or anywhere near Route 66.

**Answer to Paragraph No. 13**

Defendants admit that Penthouse's General Counsel asserted that Defendants' use was a "fair use", as well as other defenses which justify Defendants' use. Defendants affirmatively aver that the responding letter speaks for itself, and is the best evidence to what was said, as opposed to Plaintiff's characterization. Defendants deny each and every remaining allegation in Paragraph 13.

**Complaint Paragraph No. 14**

In Defendants' Pornographic Film and DVDs, no mention is made of the Highway "Route 66" by any of the "actors," nor is there any footage of the actual "Mother Road" or the American towns, people and culture which make up this iconic Highway. Defendants' Pornographic Film and DVDs could much more accurately be called "Sex in and Around the Pink Motel," since it has absolutely nothing to do with "Route 66" except for Defendants' blatant exploitation of Roxbury's Route 66 Trademark, on the cover art, packaging and menu of the DVD, an exploitation intended to confuse the consuming public as to the affiliation, source and origin of Defendants' product.

**Answer to Paragraph No. 14**

Defendants admit that actors do not mention "Route 66" by name, and further admit that there is no actual footage of the iconic and famous Route 66 and actual



1 surrounding towns. Defendants deny each and every remaining allegation in  
2 Paragraph 14.

3  
4 **JURISDICTION AND VENUE**

5 **Complaint Paragraph No. 15**

6 This action arises under the United States Lanham Act, 15 U.S.C.  
7 §1125, et seq. This Court has original jurisdiction over the subject  
8 matter of this action pursuant to 28 U.S.C. §§1331 and 1338 and 15  
9 U.S.C. §1121(a). The Court has supplemental jurisdiction over  
10 Plaintiff's state law claims under 28 U.S.C. §1367(a).

11 **Answer to Paragraph No. 15**

12 Defendants admit this action purports to arise under the Lanham Act and admit  
13 the remaining allegations in Paragraph 15.

14 **Complaint Paragraph No. 16**

15 This Court has personal jurisdiction over each of the Defendants  
16 named in this Complaint, because each Defendant does sufficient  
17 business, has sufficient minimum contacts with California and this  
18 Judicial District, and/or is resident in this Judicial District, and/or  
19 otherwise intentionally avails itself of the California and Los Angeles  
20 markets, through the sale, marketing, advertising and distribution of its  
21 products in this Judicial District, including the specific product at issue  
22 in this litigation, to render the exercise of jurisdiction over it by this  
23 Court consistent with traditional notions of fair play and substantial  
24 justice.

25 **Answer to Paragraph No. 16**

26 Defendants admit this Court has personal jurisdiction over the named  
27 Defendants in the Complaint.

28 **Complaint Paragraph No. 17**

Venue in this Judicial District is proper under 28 U.S.C.  
§§1391(b) and (c) and 1400(a), in that a substantial part of the events  
giving rise to Roxbury's claims occurred in this Judicial District,  
Defendants' products, including the offending products at issue in this

1 litigation, are sold in this Judicial District, and one or more Defendants  
2 reside and may be found in this Judicial District, within the meaning of  
3 28 U.S.C. §§1391(c) and 1400(a) .

4 **Answer to Paragraph No. 17**

5 Defendants admit this Court has venue over the named Defendants, and that  
6 venue in this Judicial District is proper.

7 **THE PARTIES**

8 **Complaint Paragraph No. 18**

9 Roxbury is a California corporation based in Santa Monica,  
10 California (steps from the official end of the Route 66 Highway), and is  
11 in the business of producing, acquiring and distributing entertainment  
12 content (classic television programs and motion pictures) for distribution  
13 via DVDs, the internet, and theatrical and television exhibition  
14 throughout the world. Roxbury's principal place of business is in Santa  
15 Monica, California, where Roxbury maintains an office and staff who  
16 oversee the development, production, acquisition, marketing,  
17 distribution and protection of its intellectual property, television  
18 programs, DVDs and films, throughout the United States and the world,  
19 and who oversee the licensing and merchandising of its intellectual  
20 properties, including and most significantly its "Route 66" registered  
21 Trademarks and Products.

22 **Answer to Paragraph No. 18**

23 Defendants are without sufficient knowledge or information to form a belief as  
24 to the truth of the allegations in Paragraph 18, and therefore deny each and every  
25 allegation in Paragraph 18.  
26

27 **Complaint Paragraph No. 19**

28 Roxbury is informed and believes, and based thereon alleges, that  
defendant Penthouse Media Group, Inc., doing business as "Penthouse,"  
is a corporation organized and existing under the laws of the State of  
Nevada, with its principal places of business in Boca Raton, Florida, and  
New York, New York. Roxbury is further informed and believes, and  
based thereon alleges, that this Defendant produces, markets and  
distributes pornographic DVDs and films throughout the United States,  
including in this Judicial District.

**Answer to Paragraph No. 19**

Defendant Penthouse Media Group Inc. affirmatively avers that it has changed its name to FriendFinder Networks Inc. Defendants deny that the DVDs and films produced, marketed and distributed by Defendants are pornographic, but affirmatively aver that they have an adult entertainment content. Defendants admit the remaining allegations in Paragraph 19.

**Complaint Paragraph No. 20**

Roxbury is informed and believes, and based thereon alleges, that defendant Penthouse Digital Media Productions, Inc., doing business as "Penthouse," is a corporation organized and existing under the laws of the State of New York, with its principal places of business in Boca Raton, Florida, and New York, New York.

**Answer to Paragraph No. 20**

Defendants deny that defendant Penthouse Digital Media Productions, Inc. principally does business in Boca Raton, Florida, and New York, New York. Defendants admit the remaining allegations in Paragraph 20.

**Complaint Paragraph No. 21**

Roxbury is further informed and believes, and based thereon alleges, that this Defendant produces, markets and distributes pornographic DVDs and films throughout the United States, including in this Judicial District.

**Answer to Paragraph No. 21**

Defendants deny that the DVDs and films produced, marketed and distributed by Defendants are pornographic, but affirmatively aver that they have an adult entertainment content. Defendants admit the remaining allegations in Paragraph 21.

**Complaint Paragraph No. 22**

Roxbury is informed and believes, and based thereon alleges, that defendant Pulse Distribution, LLC ("Pulse") is a California Limited

1 Liability Company with its principal place of business in Chatsworth,  
 2 California, is a company organized and existing under the laws of the  
 3 State of California and conducts business in, and markets, distributes  
 and sells pornographic films and DVDs throughout the United States  
 and including this Judicial District.

4 **Answer to Paragraph No. 22**

5 Defendants deny that the DVDs and films produced, marketed and distributed  
 6 by Defendants are pornographic, but affirmatively aver that they have an adult  
 7 entertainment content. Defendants admit the remaining allegations in Paragraph 22.

8 **Complaint Paragraph No. 23**

9  
 10 Roxbury is unaware of the true names and capacities of the  
 11 defendants sued herein as Does 1 through 10, inclusive, and therefore  
 12 sues these defendants by fictitious names. Roxbury will seek leave of  
 the Court to amend this Complaint to allege their true names and  
 capacities when ascertained. Roxbury is informed and believes, and  
 based thereon alleges, that each fictitiously named defendant is  
 responsible in some way for the creation, production, sale and/or  
 13 distribution of the infringing products at issue in this Complaint, and is  
 14 liable to Roxbury therefor. Penthouse, Pulse and Does 1 through 10 are  
 sometimes referred to collectively herein as "Defendants."

15 **Answer to Paragraph No. 23**

16 Defendants lack sufficient knowledge and information to form a belief as to the  
 17 truth of the allegations in Paragraph 23, and therefore deny each and every allegation  
 18 in Paragraph 23.

19 **Complaint Paragraph No. 24**

20  
 21  
 22 Roxbury is informed and believes, and based thereon alleges, that  
 23 at all times relevant herein, each of the Defendants was the agent,  
 servant or employee of each other Defendant, and at all times relevant  
 24 herein was acting in whole or at least in part within the scope of such  
 agency. As such, each and every Defendant herein is equally responsible  
 25 in whole or in part for each and every act alleged herein.

**Answer to Paragraph No. 24**

Defendants lack sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 24, and therefore deny each and every allegation in Paragraph 24.

**ALLEGATIONS COMMON TO ALL CLAIMS FOR RELIEF**

**Complaint Paragraph No. 25**

Plaintiff's Route 66 Products have been widely distributed in the United States and throughout the world continuously and pervasively since 1960. In the course of the production and distribution of these Route 66 Products, Roxbury and its predecessors in interest and licensees have expended significant effort advertising, marketing and promoting these entertainment products under titles bearing the name of, and prominently featuring, the Route 66 Mark on the products, their content, their packaging and their marketing and advertising materials.

**Answer to Paragraph No. 25**

Defendants lack sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 25, and therefore deny each and every allegation in Paragraph 25.

**Complaint Paragraph No. 26**

As a result of the success and popularity of its Route 66 Products, Roxbury and its predecessors in interest and licensees have, for almost five decades, engaged in the business of merchandising and promoting Route 66 Products throughout the US and the world.

**Answer to Paragraph No. 26**

Defendants lack sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 26, and therefore deny each and every allegation in Paragraph 26.

**Complaint Paragraph No. 27**

Beginning in 2006, Roxbury duly registered the name "Route 66" as service marks and trademarks in several applicable entertainment classifications, under the Lanham Act, 15 U.S.C. §1051 et seq., and Roxbury remains to this date the exclusive owner of these Registered and Common Law Trademarks for "Route 66" on or in connection with their entertainment products and services.

**Answer to Paragraph No. 27**

Defendants deny that the Plaintiff is the exclusive owner of registered trademarks for the term "Route 66", and deny Plaintiff owns exclusive rights to the historic and iconic term "Route 66" for all entertainment products and services. Defendants are without sufficient knowledge or information to form a belief as to the truth of the remaining allegations in Paragraph 27, and therefore deny each and every remaining allegation in Paragraph 27.

**Complaint Paragraph No. 28**

Roxbury and its predecessors-in-interest have developed an excellent reputation and highly valuable goodwill in the Route 66 Trademark, and the products, goods and services featuring that Trademark. Through the consistent and extensive advertising and widespread distribution and success of Roxbury's Products featuring the Route 66 Trademark, the advertising and distribution of merchandise featuring the Route 66 Trademark, and the use of the Route 66 Trademark in national and/or regional advertising campaigns, a secondary meaning has been created in the minds of the public throughout the United States, and throughout the world, by which the Route 66 Trademark has become strongly identified and associated with Roxbury and Roxbury's series of television programs, films, DVDs and merchandise featuring the Route 66 Mark. Roxbury therefore has acquired common law trademark rights in the Route 66 Trademark in addition to its federally-registered Route 66 Marks.

**Answer to Paragraph No. 28**

Defendants deny that Plaintiff has developed highly valuable goodwill in the Route 66 Trademark, deny that a secondary meaning exists in the minds of the public throughout the United States and throughout the world by which the Route 66 Trademark has been identified and associated with Roxbury and deny that Roxbury

1 has acquired common law trademark rights in the Route 66 Trademark. Defendants  
 2 are without sufficient knowledge or information to form a belief as to the truth of the  
 3 remaining allegations in Paragraph 28 and therefore, deny each and every remaining  
 4 allegation in Paragraph 28.

#### 5 Complaint Paragraph No. 29

6 In addition, and also as a result of the extensive advertising and  
 7 widespread distribution and success of Roxbury's Route 66 Products,  
 8 the advertising and distribution of merchandise featuring the Route 66  
 9 Trademark, and the use of the Route 66 Trademark in national and/or  
 10 regional advertising campaigns, the Route 66 Trademarks are famous  
 11 throughout the United States and the world and are immediately  
 12 recognizable to and known by the public.

#### 13 Answer to Paragraph No. 29

14 Defendants admit the term "Route 66" is famous, historic and iconic in  
 15 America, as well as known by the public, but deny the public recognizes the term as a  
 16 trademark owned exclusively by Plaintiff. Defendants lack sufficient knowledge or  
 17 information to form a belief as to the remaining allegations in Paragraph 29, and  
 18 therefore deny each and every remaining allegation in Paragraph 29.

#### 19 Complaint Paragraph No. 30

20 Roxbury is informed and believes, and based thereon alleges, that  
 21 Defendants have exploited Defendants' Pornographic Film and DVDs,  
 22 prominently featuring and exploiting the Route 66 Trademark, by  
 23 without limitation, advertising and distributing such products in  
 24 interstate commerce and throughout the United States, including Los  
 25 Angeles.

#### 26 Answer to Paragraph No. 30

27 Defendants admit that they have distributed products in interstate commerce,  
 28 including in Los Angeles. Defendants deny each and every remaining allegation in  
 Paragraph 30.

**Complaint Paragraph No. 31**

Roxbury has demanded that Defendants cease selling Defendants' Pornographic Film and DVDs featuring and exploiting the Route 66 Trademark, but Defendants have refused to do so.

**Answer to Paragraph No. 31**

Defendants admit Roxbury has demanded the Defendants cease selling DVDs and film featuring the title "Route 66". Defendants deny each and every remaining allegation in Paragraph 31.

**Complaint Paragraph No. 32**

Defendants have never sought from Roxbury, nor has Roxbury every granted Defendants, permission or consent to utilize or exploit the Route 66 Trademark on or in connection with any goods or merchandise or for any purpose whatsoever, or to authorize others to engage in any of the foregoing activities.

**Answer to Paragraph No. 32**

Defendants admit the allegations in Paragraph 32.

**Complaint Paragraph No. 33**

By designing, manufacturing, reproducing, advertising, marketing, displaying, selling, distributing and otherwise exploiting their Pornographic Film and DVDs featuring the Route 66 Trademark, and/or by authorizing or contributing to the foregoing, Defendants have obtained for themselves a benefit which is otherwise paid for by others and have obtained valuable property rights belonging to Roxbury without having paid for them.

**Answer to Paragraph No. 33**

Defendants deny each and every allegation in Paragraph 33.



**FIRST CLAIM FOR RELIEF**

**Against All Defendants for Violation of**

**Section 43(a) of the Lanham Act**

**Complaint Paragraph No. 34**

Roxbury Entertainment realleges and incorporates by this reference the allegations contained in paragraphs 1 through 33, inclusive, as though they were fully set forth herein.

**Answer to Paragraph No. 34**

Defendants incorporate their answers to Paragraphs 1 through 33 as their answer to Paragraph 34.

**Complaint Paragraph No. 35**

By, without limitation, designing, manufacturing, reproducing, importing, advertising, marketing, displaying, selling, distributing, licensing and otherwise exploiting Defendants' Pornographic Film and DVDs prominently bearing the trademark "Route 66" on the product, its packaging and its marketing and advertising materials, Defendants have created, and will continue to create, a likelihood of confusion in the marketplace as to the source of Defendants' Pornographic Film and DVDs, and have falsely created the impression in the minds of the consuming public that Defendants are somehow associated, affiliated or connected with Roxbury Entertainment and its Route 66 Products, that Roxbury sponsored or endorsed the merchandise at issue, and/or that Roxbury approved or authorized Defendants' use of its Route 66 Trademark on Defendants' Pornographic Film and DVDs. Such conduct violates Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a).

**Answer to Paragraph No. 35**

Defendants deny each and every allegation in Paragraph 35.

**Complaint Paragraph No. 36**

As a direct and proximate result of Defendants' wrongful conduct, Roxbury has been damaged and is entitled to recover Defendants' wrongfully obtained profits and three times Roxbury's actual damages, pursuant to 15 U.S.C. §1117(a).

**Answer to Paragraph No. 36**

Defendants deny each and every allegation in Paragraph 36.

**Complaint Paragraph No. 37**

Defendants' violation of the Lanham Act has caused and will cause irreparable harm to Roxbury which cannot be fully compensated by money. Roxbury has no adequate remedy at law. Therefore, in addition to monetary relief, Roxbury is entitled to preliminary and permanent injunctive relief preventing Defendants from continuing to use the Route 66 Trademark on or in connection with the sale of its Pornographic Film or DVDs, or any confusingly similar variations, or in connection with any products, goods or services.

**Answer to Paragraph No. 37**

Defendants deny each and every allegation in Paragraph 37.

**Complaint Paragraph No. 38**

Defendants engaged in the foregoing conduct knowingly, willfully and oppressively, intending to appropriate Roxbury's intellectual property to the detriment of Roxbury and to the confusion of the public. This constitutes an exceptional case within the meaning of Section 35 of the Lanham Act, 15 U.S.C. §1117, for which Roxbury should recover its attorneys' fees and costs incurred in connection herewith.

**Answer to Paragraph No. 38**

Defendants deny each and every allegation in Paragraph 38.

**SECOND CLAIM FOR RELIEF**

**Against All Defendants for Federal Trademark Infringement**

**Complaint Paragraph No. 39**

Roxbury realleges and incorporates by this reference the allegations contained in paragraphs 1 through 38, inclusive, as though they were fully set forth herein.

**Answer to Paragraph No. 39**

Defendants incorporate their answers to Paragraphs 1 through 38 as their answer to Paragraph 39.

**Complaint Paragraph No. 40**

Defendants' unauthorized use of a counterfeit, copy or precise imitation of Roxbury's Registered Trademarks on and in connection with Defendants' Pornographic Film and DVDs creates confusion in the marketplace and constitutes an infringement of Roxbury's Registered Trademarks in violation of 15 U.S.C. §1114. Roxbury is informed and believes, and based thereon alleges, that Defendants' use and exploitation of the Route 66 Mark was willful, intentional, that Defendants were aware and are aware of Roxbury's Registered and Common Law Trademarks, and that Defendants purposefully used Roxbury's Trademarks to trade on Roxbury's reputation, to cause confusion, mistake and/or deception, and to take advantage of the goodwill and public recognition associated with the Route 66 Trademarks for their own commercial advantage.

**Answer to Paragraph No. 40**

Defendants deny each and every allegation in Paragraph 40.

**Complaint Paragraph No. 41**

As a direct and proximate result of Defendants' trademark infringement, Roxbury has been damaged and is entitled to recover Defendants' wrongfully obtained profits and three times Roxbury's actual damages, pursuant to 15 U.S.C. §1117(a).

**Answer to Paragraph No. 41**

Defendants deny each and every allegation in Paragraph 41.

**Complaint Paragraph No. 42**

Defendants' trademark infringement has caused and will cause irreparable harm to Roxbury which cannot be fully compensated by money. Roxbury has no adequate remedy at law. Therefore, in addition to monetary relief, Roxbury is entitled to preliminary and permanent injunctive relief preventing Defendants from continuing to use Roxbury's Route 66 Trademark, or any confusingly similar variations, on or in connection with any products, goods or services.

**Answer to Paragraph No. 42**

Defendants deny each and every allegation in Paragraph 42.

**Complaint Paragraph No. 43**

Defendants engaged and continue to engage in the foregoing conduct knowingly, willfully and oppressively, intending to appropriate Roxbury's intellectual property to the detriment of Roxbury and to the confusion of the public. This constitutes an exceptional case within the meaning of Section 35 of the Lanham Act, 15 U.S.C. §1117, for which Roxbury should recover its attorneys' fees and costs incurred herein.

**Answer to Paragraph No. 43**

Defendants deny each and every allegation in Paragraph 43.

**THIRD CLAIM FOR RELIEF**

**Against All Defendants for Violation of**  
**Federal Anti-Dilution Law (15 U.S.C. §1125(c))**

**Complaint Paragraph No. 44**

Roxbury realleges and incorporates by this reference the allegations contained in paragraphs 1 through 43, inclusive, as though they were fully set forth herein.

**Answer to Paragraph No. 44**

Defendants incorporate their answers to Paragraphs 1 through 43 as their answer to Paragraph 44.

**Complaint Paragraph No. 45**

By, without limitation, designing, manufacturing, reproducing, importing, advertising, marketing, displaying, selling, distributing, licensing and otherwise exploiting Defendants' Pornographic Film and DVDs, Defendants have created, and will continue to create, a likelihood of dilution and tarnishment of the distinctive and superior quality of Roxbury's famous Route 66 Trademark and Route 66 Products, because Roxbury cannot control the quality of Defendants'

merchandise or the manner in which Defendants utilize that Trademark on and in Defendants' merchandise.

**Answer to Paragraph No. 45**

Defendants deny each and every allegation in Paragraph 45.

**Complaint Paragraph No. 46**

Defendants' Pornographic Film and DVDs are grossly inferior products to those of Plaintiff, featuring little or no dialogue by "actors" who display no apparent acting talent and are so embarrassed by their performances that they use pseudonyms to hide their true identities, and contain no storylines or themes other than the very graphic exhibitions of oral, anal and violent sex between and among various men and women in a random fashion.

**Answer to Paragraph No. 46**

Defendants deny each and every allegation in Paragraph 46.

**Complaint Paragraph No. 47**

Roxbury is informed and believes, and based thereon alleges, that Defendants' use and exploitation of the Route 66 Trademarks was willful and intentional, that Defendants were and are aware of Roxbury's Registered and Common Law Trademarks, and that Defendants purposefully used and continue to use Roxbury's Trademarks to trade on Roxbury's reputation, to cause confusion, mistake and/or deception, and to take advantage of the goodwill and public recognition associated with the Route 66 Trademark and Products for their own commercial advantage.

**Answer to Paragraph No. 47**

Defendants deny each and every allegation in Paragraph 47.

**Complaint Paragraph No. 48**

Accordingly, as a direct and proximate result of Defendants' wrongful conduct, Roxbury has been substantially damaged and is entitled to recover Defendants' wrongfully obtained profits and three times Roxbury's actual damages, pursuant to 15 U.S.C. §1117(a).

**Answer to Paragraph No. 48**

Defendants deny each and every allegation in Paragraph 48.

**Complaint Paragraph No. 49**

Defendants' violation of the Federal Anti-Dilution Law has caused and will cause irreparable harm to Roxbury which cannot be fully compensated by money. Roxbury has no adequate remedy at law. Therefore, in addition to monetary relief, Roxbury is entitled to preliminary and permanent injunctive relief preventing Defendants from continuing to use Roxbury's Route 66 Trademarks, or any confusingly similar variations, on or in connection with any products, goods or services.

**Answer to Paragraph No. 49**

Defendants deny each and every allegation in Paragraph 49.

**Complaint Paragraph No. 50**

Defendants engaged and continue to engage in the foregoing conduct knowingly, willfully and oppressively, intending to appropriate Roxbury's intellectual property to the detriment of Roxbury and to the confusion of the public. This constitutes an exceptional case within the meaning of Section 35 of the Lanham Act, 15 U.S.C. §1117, for which Roxbury should recover its attorneys' fees and costs incurred herewith.

**Answer to Paragraph No. 50**

Defendants deny each and every allegation in Paragraph 50.

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**FOURTH CLAIM FOR RELIEF**

**Against All Defendants for Violation**

**of State Anti-Dilution Law**

**(California Business & Professions Code §14330)**

**Complaint Paragraph No. 51**

Roxbury realleges and incorporates by this reference the allegations contained in paragraphs 1 through 50, inclusive, as though they were fully set forth herein.

**Answer to Paragraph No. 51**

Defendants incorporate their answers to Paragraphs 1 through 50 as their answer to Paragraph 51.

**Complaint Paragraph No. 52**

Roxbury's Route 66 Trademark is a strong and well recognized mark and thus entitled to protection as a "distinctive mark" under the California Anti-Dilution statute, California Business and Professions Code §14330.

**Answer to Paragraph No. 52**

Defendants deny each and every allegation in Paragraph 52.

**Complaint Paragraph No. 53**

By, without limitation, designing, manufacturing, reproducing, importing, advertising, marketing, displaying, selling, distributing, licensing and otherwise exploiting Defendants' Pornographic Film and DVDs, Defendants have created, and will continue to create, a likelihood of injury to Roxbury's business reputation and/or dilution of the distinctive quality of the Route 66 Trademarks, and Roxbury's reputation and products associated therewith, in violation of the California Business and Professions Code §14330(a).

**Answer to Paragraph No. 53**

Defendants deny each and every allegation in Paragraph 53.

**Complaint Paragraph No. 54**

As a direct and proximate result of the foregoing conduct of Defendants, Roxbury has suffered and continues to suffer monetary damages and is therefore entitled to an award of such damages in an amount to be proven at trial.

**Answer to Paragraph No. 54**

Defendants deny each and every allegation in Paragraph 54.

**Complaint Paragraph No. 55**

Defendants' violation of California's Anti-Dilution Law has caused and will continue to cause irreparable harm to Roxbury which cannot be fully compensated by money. Roxbury has no adequate remedy at law. Therefore, in addition to monetary relief, Roxbury is entitled to preliminary and permanent injunctive relief preventing Defendants from continuing to use Roxbury's Route 66 Trademarks, or any confusingly similar variations, on or in connection with its Pornographic Film and DVDs and/or any other products, goods or services.

**Answer to Paragraph No. 55**

Defendants deny each and every allegation in Paragraph 55.

**FIFTH CLAIM FOR RELIEF**

**Against All Defendants for Common Law Unfair Competition**

**Complaint Paragraph No. 56**

Roxbury realleges and incorporates by this reference the allegations contained in paragraphs 1 through 55, inclusive, as though they were fully set forth herein.

**Answer to Paragraph No. 56**

Defendants incorporate their answers to Paragraphs 1 through 55 as their answer to Paragraph 56.



**Complaint Paragraph No. 57**

By their conduct as alleged above, Defendants have violated and infringed Roxbury's common law rights in its Route 66 Trademarks, and have otherwise competed unfairly with Roxbury and Roxbury's authorized licensees in violation of the common law of the State of California.

**Answer to Paragraph No. 57**

Defendants deny each and every allegation in Paragraph 57.

**Complaint Paragraph No. 58**

As a direct and proximate result of Defendants' conduct, Roxbury has suffered and is entitled to monetary damages in an amount to be proven at trial.

**Answer to Paragraph No. 58**

Defendants deny each and every allegation in Paragraph 58.

**Complaint Paragraph No. 59**

By their conduct as described above, Defendants have engaged in outrageous and despicable conduct and have acted with ill will, malice and oppression toward Roxbury and in conscious disregard of Roxbury's rights. Roxbury is therefore entitled to recover, in addition to actual damages, exemplary and punitive damages under California Civil Code §3294, in an amount sufficient to punish and make an example of Defendants.

**Answer to Paragraph No. 59**

Defendants deny each and every allegation in Paragraph 59.

**Complaint Paragraph No. 60**

Defendants' unlawful conduct has caused and continues to cause irreparable harm to Roxbury which cannot be fully compensated by money. Roxbury has no adequate remedy at law. Therefore, in addition to monetary relief, Roxbury is entitled to preliminary injunctive relief enjoining Defendants from engaging in further acts of unfair competition.

**Answer to Paragraph No. 60**

Defendants deny each and every allegation in Paragraph 60.

**SIXTH CLAIM FOR RELIEF**

**Against All Defendants for Statutory Unfair Competition**

**(California Business & Professions Code §17200 et seq.)**

**Complaint Paragraph No. 61**

Roxbury realleges and incorporates by this reference the allegations contained in paragraphs 1 through 60, inclusive, as though they were fully set forth herein.

**Answer to Paragraph No. 61**

Defendants incorporate their answers to Paragraphs 1 through 60 as their answer to Paragraph 61.

**Complaint Paragraph No. 62**

By their conduct as described above, Defendants have intentionally and willfully engaged in unlawful, unfair and fraudulent methods of competition, and unfair or deceptive acts or practices in violation of §17200 et seq. of the California Business and Professions Code.

**Answer to Paragraph No. 62**

Defendants deny each and every allegation in Paragraph 62.

**Complaint Paragraph No. 63**

Defendants' conduct has caused and will cause irreparable harm to Roxbury which cannot be fully compensated by money. Roxbury has no adequate remedy at law. Therefore, Roxbury is entitled to preliminary and permanent injunctive relief enjoining Defendants from engaging in further unfair and deceptive trade practices.

**Answer to Paragraph No. 63**

Defendants deny each and every allegation in Paragraph 63.

**Complaint Paragraph No. 64**

Roxbury is further entitled to an order pursuant to §17203 of the California Business and Professions Code restoring to Roxbury all of its interest in monies that were acquired by Defendants by means of any unlawful acts or practices hereunder.

**Answer to Paragraph No. 64**

Defendants deny each and every allegation in Paragraph 64.

**SEVENTH CLAIM FOR RELIEF**

**Against All Defendants for Unjust Enrichment**

**Complaint Paragraph No. 65**

Roxbury realleges and incorporates by this reference the allegations contained in paragraphs 1 through 64, inclusive, as though they were fully set forth herein.

**Answer to Paragraph No. 65**

Defendants incorporate their answers to Paragraphs 1 through 64 as their answer to Paragraph 65.

**Complaint Paragraph No. 66**

By their conduct as alleged above, Defendants have unjustly retained a benefit to the detriment of Roxbury, and such benefit violates the fundamental principles of justice, equity and good conscience.

**Answer to Paragraph No. 66**

Defendants deny each and every allegation in Paragraph 66.

**Complaint Paragraph No. 67**

Accordingly, Roxbury is entitled to an order requiring Defendants to disgorge any and all such ill-gotten gains to Roxbury.

**Answer to Paragraph No. 67**

Defendants deny each and every allegation in Paragraph 67.

**AFFIRMATIVE DEFENSES**

**First Affirmative Defense**

Plaintiff's Complaint fails to state a claim upon which relief could be granted.

**Second Affirmative Defense**

Any rights owned by Plaintiff are extremely weak, as the term "Route 66" is part of the lexicon of America and has historic and cultural significance. As a result, it is highly diluted and has been used for many years by numerous third parties in connection with a variety of goods and services, including, but not limited to, entertainment products and services. As such, and by reason of Plaintiff's failure to police and enforce its perceived rights against third parties, any rights owned by Plaintiff have either been waived, or are too narrow to stop the use complained of here.

**Third Affirmative Defense**

Plaintiff has failed to plead sufficient facts demonstrating any claimed rights or valid assignments from their alleged predecessors-in-interest.

**Fourth Affirmative Defense**

Plaintiff has failed to plead facts sufficient to show an ownership interest in the trademarks in question.

**Fifth Affirmative Defense**

Plaintiff's claimed mark does not qualify as a "famous" mark under the Lanham Act, and the term "Route 66" is already highly diluted. Therefore, its dilution claim must be dismissed.

**Sixth Affirmative Defense**

To the extent Plaintiff's state law claims seek relief that is inconsistent with limitations under Federal law, these claims are barred by preemption.

1 **Seventh Affirmative Defense**

2 Plaintiff's claims are barred under the equitable doctrine of unclean hands.  
3 Specifically, on information and belief, Plaintiff and its predecessors-in-interest,  
4 falsely claimed exclusive rights and/or continuous use in regard to the trademarks in  
5 question and therefore, committed fraud on the United States Patent and Trademark  
6 Office.

7 **Eighth Affirmative Defense**

8 The "Route 66" term is merely descriptive as it is an icon in American culture  
9 and it is descriptive of themes involving American culture along the iconic highway,  
10 irrespective of whether that highway is actually depicted in works of art.

11 **Ninth Affirmative Defense**

12 Defendants' use of "Route 66" in combination with use of Penthouse's famous  
13 housemark PENTHOUSE is a fair use authorized by the Lanham Act and authorized  
14 by well recognized cases dealing with titles where the term has artistic relevance to  
15 the underling work (see e.g. Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 902 (9<sup>th</sup>  
16 Cir. 2002)).

17 **Tenth Affirmative Defense**

18 Defendants' use of "Route 66" is protected expression under the First  
19 Amendment of the United States Constitution.

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1 WHEREFORE, Defendants, Penthouse Media Group Inc., a Nevada  
2 corporation, n/k/a FriendFinder Networks Inc., Penthouse Digital Media Productions,  
3 Inc., a New York corporation and Pulse Distribution, LLC, a California LLC, pray for  
4 dismissal of all claims against them, for judgment in their favor, and for an award of  
5 attorney's fees as the prevailing party pursuant to 15 U.S.C. § 1117. Additionally,  
6 pursuant to § 37 of the Lanham Act, 15 U.S.C. § 1119, Defendants request that  
7 Plaintiff's trademark registrations be cancelled for the reasons set forth above in the  
8 Affirmative Defenses.

9 Respectfully submitted this 30th day of July, 2008.

10 PENTHOUSE MEDIA GROUP INC. a  
11 Nevada corporation, n/k/a FriendFinder  
12 Networks Inc.; PENTHOUSE DIGITAL  
13 MEDIA PRODUCTIONS, INC., a New York  
14 corporation; PULSE DISTRIBUTION, LLC, a  
15 California LLC

16 By: /s/ Kristin L. Holland  
17 One of Their Attorneys

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